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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.      | CONFIRMATION NO. |
|-----------------|-------------|----------------------|--------------------------|------------------|
| 10/798,864      | 03/11/2004  | Evan Pennell         | 00216-661001 / Case 8131 | 6604             |

26161 7590 09/15/2009  
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| EXAMINER |
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CHOI, STEPHEN

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| ART UNIT | PAPER NUMBER |
|----------|--------------|

3724

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| NOTIFICATION DATE | DELIVERY MODE |
|-------------------|---------------|

09/15/2009

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* EVAN PENNELL, ALEJANDRO LEE, VINCENT WALKER,  
ROBERT TROTTA, KEVIN POWELL and JOHN YUSKOWSKI

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Appeal 2009-005025  
Application 10/798,864  
Technology Center 3700

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Decided: September 11, 2009

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Before: WILLIAM F. PATE, III, JENNIFER D. BAHR and  
FRED A. SILVERBERG, *Administrative Patent Judges*.

PATE, III, *Administrative Patent Judge*.

DECISION ON APPEAL

## STATEMENT OF CASE

Appellant appeals under 35 U.S.C. § 134 from a rejection of claims 1, 3, 5, 7, 8, 12, 13, 24, 27-33, 35 and 36<sup>1</sup>. App. Br. 1. We have jurisdiction under 35 U.S.C. § 6(b).

The claims are directed to a shaving razor blade unit. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A shaving razor blade unit comprising
  - a housing having a primary guard at a front of said housing and a primary cap at an upper surface at a back of said housing, one or more primary shaving blades between said primary guard and said primary cap, and
  - an assembly comprising
    - a blade carrier defining a rear wall having a rear exterior surface extending downward from said upper surface at the back of said housing to a terminating surface, and
    - a trimming blade mounted on said rear wall and having a trimming cutting edge extending at least partially beyond said terminating surface inside of an imaginary extension of said rear exterior surface, said rear exterior surface extending along substantially the entire length of the trimming blade and defining a trimming cap for said trimming blade,
  - wherein said housing is made of plastic, said assembly is mounted on said housing, and said blade carrier is formed from sheet metal.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

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|------------|--------------------|---------------|
| Rozenkranc | US 6,276,061 B1    | Aug. 21, 2001 |
| Brown      | US 2004/0055156 A1 | Mar. 25, 2004 |

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<sup>1</sup> It is noted that claims 28-32 depend from withdrawn claims. It is also noted that we do not have jurisdiction to review requirements for election and/or restriction. App. Br. 1, 20. 37 C.F.R. §§ 1.141 and 1.181.

Claims 35 and 36 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Brown. Ans. 3.

Claims 1, 3, 5, 12, 13, 24, 27-29, 32, 33, 35, and 36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Rozenkranc. Ans. 3.

Claims 1, 3, 5, 12, 13, 24, 27-30, 32, and 33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Brown. Ans. 4.

Claims 1, 3, 5, 7, 8, 12, 13, 24, 27-33, 35, and 36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Rozenkranc in view of Applicant's Admitted Prior Art (hereinafter "AAPA"). Ans. 5.

Claims 7, 8, and 31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Brown and AAPA. Ans. 7.

### OPINION

"[T]he precise language of 35 U.S.C. § 102 that '(a) person shall be entitled to a patent unless,' concerning novelty and unobviousness, clearly places a burden of proof on the Patent Office which requires it to produce the factual basis for its rejection of an application under sections 102 and 103." *In re Warner*, 379 F.2d 1011, 1016 (CCPA 1967). The express, implicit, and inherent disclosures of a prior art reference may be relied upon in the rejection of claims under 35 U.S.C. §§ 102 or 103. In relying upon the theory of inherency, however, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art. *Ex parte Levy*, 17 USPQ2d 1461, 1464 (BPAI 1990).

While the Examiner opines that claims 35 and 36 are anticipated by Brown, we are unable to discern the Examiner's factual basis for reaching

this conclusion. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987). The Examiner does not specify what elements of Brown are interpreted as the claimed housing and rear wall of a blade carrier having a trimming blade mounted thereon. The Examiner indicates that Brown's rear housing member 4 is read as the claimed "blade carrier" and Brown's auxiliary blade 36 is read as the claimed "trimming blade." Ans. 3. Although the Examiner has not identified the structure of Brown read as the "trimming guard" Brown identifies a trimming guard surface 33 defined by bar 32. Brown para. [0017]. While Brown indicates that auxiliary blade 36 is affixed to the head body 2, Brown does not describe the structural relationship between the rear housing member 4, the auxiliary blade 36, and the guard surface 33 defined by bar 32. From Figure 2 it appears that Brown's auxiliary blade is mounted in either rear housing member 4 or bar 32 (*cf.* Ans. 14 *and* App. Br. 16-17). Brown does not confirm either configuration. Brown para. [0017]. Due to this lack of description, the Examiner has not established that claim 35, which requires a housing and an assembly including a trimming blade mounted on a rear wall defined by a blade carrier, is anticipated by Brown. App. Br. 15-17. For the same reason, the Examiner has also not established that claim 36, which requires a trimming assembly, including a trimming blade mounted on a blade carrier and a trimming guard, which is attached as one unitary piece to the housing, is anticipated by Brown. App. Br. 17.

The key to supporting any *prima facie* conclusion of obviousness under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the

claimed invention would have been obvious. The Supreme Court in *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) noted that the analysis supporting a rejection under 35 U.S.C. § 103 should be made explicit. The Federal Circuit has stated that “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006), cited with approval in *KSR*, 550 U.S. at 418.

Since the same factual findings discussed above regarding Brown form the basis for the Examiner’s rejection of claims 1, 3, 5, 12, 13, 24, 27-30, 32, and 33 under 35 U.S.C. § 103(a) as being unpatentable over Brown, this rejection also cannot be sustained. Ans. 4-5, 14; App. Br. 18, 19.

Regarding Rozenkranc, the Examiner reads the curved region at the lower left-hand side of Figure 1 as the “rear exterior surface [of the rear wall defined by the blade carrier].” Ans. 9-10, fig. A. This curve also represents the structure that the Examiner has interpreted as the claimed “blade carrier.” Ans. 3-4, 8-10. The Examiner cites to Figure 3a for the “trimming guard” referring to the structure represented by the region having a V-shaped groove located on the opposite side of the trimming blade 4 from the curved region read as the “blade carrier.” The Examiner does not specify whether Rozenkranc is interpreted as teaching a trimming assembly, including a trimming blade mounted on a blade carrier and a trimming guard, that is attached as one unitary piece to the housing or if the Examiner opines this would have been an obvious modification to the Rozenkranc device to provide the trimming assembly attached as one unitary structure to the housing. Ans. 3-4, 11.

Rozenkranc does not specifically discuss the relationship between the trim blade 4, and the regions cited by the Examiner as the “blade carrier” and the “trim guard.” *See* Rozenkranc col. 2, ll. 23-33. Presumably, these regions are components of Rozenkranc’s head body 2. Rozenkranc indicates that, preferably, the trim blade is mounted within the body in the same slot as the shaving blades by, for example, lengthening the body to accommodate the trim blade. Rozenkranc col. 1, ll. 39-45. Presumably the trim blade 4 is mounted on the L-shaped structure affixed to the trim blade, depicted in cross section in Figure 1, and that L-shaped structure is connected to the head body in some way.

The Examiner opines that “[Rozenkranc’s] trim blade is mounted to all parts of the assembly portion by their common connection.” Ans. 9. Rozenkranc does not detail the “common connection” referred to by the Examiner. It is not reasonable to interpret Rozenkranc’s trim blade as “mounted on” any and all parts of Rozenkranc’s shaving apparatus in order to conclude that it is mounted on the rear wall defined by the blade carrier, as required by claims 1 and 35. This interpretation would allow essentially any element of Rozenkranc’s apparatus, including the curved surface cited by the Examiner, to be considered the “blade carrier” on which the trimming blade is mounted. Such an interpretation is not consistent with the Specification which indicates that the term “blade carrier” refers to the structure supporting the blade in the housing and not any part of the housing or shaving apparatus. Spec. 4:14-18. For these reasons, the Examiner has not established that the limitation of claims 1 and 35 requiring “a trimming blade mounted on [the] rear wall [defined by the blade carrier]” is met by Rozenkranc. App. Br. 5-8, 9.

If the regions cited by the Examiner as the “blade carrier” and the “trim guard” are part of the housing or body 2, it is not reasonable to also regard those regions as elements “attached” to the housing. The claim requires the housing, blade carrier and trim guard to be separate elements. We cannot agree that *Nerwin v. Erlichman*, 168 USPQ 177 (BPAI 1969), provides the necessary rational underpinning to support the conclusion that it would have been an obvious matter of design choice to modify Rozenkranc to provide a separate trimming assembly, including the blade carrier, trim blade and trim guard, attached as one unitary piece to the housing. Ans. 3, 11. Section 103 requires a fact-intensive comparison of the claimed invention with the prior art rather than the mechanical application of one or another per se rule. *In re Ochiai* 71 F.3d 1565, 1571 (Fed. Cir. 1995). Since the Examiner has not provided any facts or rationale to establish that it would have been obvious to modify Rozenkranc to provide a separate trimming assembly, including the blade carrier, trim blade and trim guard, attached as one unitary piece to the housing, the rejection of claims 3 and 36 under 35 U.S.C. § 103(a) as being unpatentable over Rozenkranc cannot be sustained. App. Br. 11. The rejection of dependent claims 5, 12, 13, 24, 27-29, 32, and 33 under 35 U.S.C. § 103(a) as being unpatentable over Rozenkranc also cannot be sustained.

The Examiner has not indicated what Admission by Appellants is relied upon in the rejection of claims 1, 3, 5, 7, 8, 12, 13, 24, 27-33, 35, and 36 over Rozenkranc or Brown and AAPA. Disclosing alternative structures in the Specification does not amount to an admission that those structures are known in the prior art. Ans. 6-8. Although Appellant has cited patent publications to Apprille, Carson and Metcalf on an Information Disclosure



Statement, the Examiner has not indicated what portion, if any, of these references are being applied against the pending claims. Ans. 6-8.

Regardless, the disclosures that the Examiner refers to as AAPA, as applied by the Examiner, do not cure the deficiencies of Brown and Rozenkranc noted above. The rejections of claims 1, 3, 5, 7, 8, 12, 13, 24, 27-33, 35, and 36 as being unpatentable over Rozenkranc and AAPA, and of claims 7, 8, and 31 as being unpatentable over Brown and AAPA, also cannot be sustained.

#### DECISION

For the above reasons, the Examiner's rejections of claims 1, 3, 5, 7, 8, 12, 13, 24, 27-33, 35 and 36 are reversed.

#### REVERSED

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